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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,062	12/23/1999	TADASHI OHASHI	1341.1037/JD	8272

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EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/472,062

**Applicant(s)**

OHASHI, TADASHI

**Examiner**

Maikhanh Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/14/06 & 8/17/06.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed 11/20/2006 to the original application filed 12/23/1999.

Claims 1-11 are presented for examination. Claims 1, 6, and 9 have been amended.

Claims 1, 6 and 9 are independent claims.

### **Request Continuation for Examination**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/20/2006 has been entered.

### Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Serbinis et al.** (US 6,584,466, filed 04/1999) in view of **Usdin et al.** “*XML: Not a Silver Bullet, But a Great Pipe Wrench*” (09/1998) and further in view of **Okimoto et al.** (US 6552814, filed 11/04/1998).

#### As to claims 6 and 9:

Serbinis teaches a document retrieval device used in an integrated document management system (*see the Abstract and col.3, lines 14-19*) comprising:

- a storage unit (*e.g., store 30; col.5, lines 47-49*) which stores therein a document database (*e.g., database 25; col.5, lines 27-62*) comprising plurality of documents that are files (*e.g., electronic documents or files; col.5, lines 35-37*) together forming a hierarchical structure (*e.g., hierarchical storage scheme for storing electronic documents; col.7, lines 16-22*) comprising an hierarchy upper layer and hierarchy lower layer ranked below the upper the upper hierarchy layer where document files, each containing a document, in the lower hierarchy

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are referenced above in the upper hierarchy layer (*e.g., each document version instance 74A and 74B includes a reference to the parent; col.7, lines 47-48 and also see fig.7*), where the structure is defined with hypertext described in an extended markup language (*e.g., XML; col.16, lines 1-25*);

- a management information database comprising management information (*col.9, lines 19-32*), wherein the document in the upper hierarchy layer is separate and distinct from the document in the lower hierarchy layer (*e.g., DMS system 17 ... supports multiple versions of documents ... maintain the relationships between the documents; col.7, lines 42-57*); and
- a server connected to said storage unit (*e.g., store 30 is connected to server computer; col.5, lines 36-47 & Figs. 1A-B*) and provided a manager of the documents (*e.g., control data concerning documents; col.5, lines 27-28*), the document retrieval device retrieving together, based on the management information, both the document in the upper layer and the document in the lower layer in a specified version from the document database (*col.12, lines 24-59*).

Serbinis does not explicitly teach “*an XML file defining the hierarchical structure by indicating a relation between a document in the upper hierarchy layer and document in the lower hierarchy layer, a document type definition file describing*

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*information on a version number of each document, and a document style sheet file defining a style of each document.”*

Usdin teaches an XML file defining the hierarchical structure by indicating a relation between a document in the upper layer and a document in the lower layer (*e.g., XML assumes that data are hierarchically structured ... which consist of name ‘root’ element which begins at the beginning of the document ... The hierarchical structure is fairly obvious in text documents ... a section starts ... the same level ... A section ... subsections; page 126*), a document type definition file describing information on a version number of each document (*e.g., Document Type Definition ... specify what the root element is for a document type ... define the contents of elements ... define relationships among the contents of various elements; page 127; right column – page 128, left column*), and a document style sheet file define a style of each document (*e.g., The language for stylesheets for XML documents; page 128, right column*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Serbinis with Usdin because Usdin’s teaching would have provided the capability for describing the structure and syntax of XML documents, and identifying all of the types of information that are needed for searching, retrieving, formatting, and tracking.

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The combination of Serbinis and Usdin, however, does not specifically teach "*the management information includes a tag which instructs to overlay predetermined characters on the document, such that a printer at a client makes a hard copy of the retrieved document including the overlaid characters.*"

Okimoto teaches the management information includes a tag which instructs to overlay predetermined characters on the document, such that a printer at a client makes a hard copy of the retrieved document including the overlaid characters (*e.g., an overlay macro for forming an overlay image on an original image ... when the user wishes to obtain a plurality of document sets, the present invention enables the user to set a different macro or a combination of different macros for each document set so as to obtain different printing results for each of different document sets ... a document copy in a first style ST1 shown in FIG. 2(a), a first document modification in a second style ST2 shown in FIG. 2(b), and a second document modification in a third style ST3 shown in FIG. 2(c). The copy printed in the first style ST1 includes only an original image based on original print data. The user may use the copy for himself/herself. However, the first modified copy printed in the second style ST2 also includes, over the original image, a first overlay image "Confidential" based on a first form-overlay data. The user may hand out the first modified copy to workers in his/her office. Further, the second modified copy printed in the third style ST3 further includes, that is, in addition to the first overlay image "Confidential", a second overlay image "LOGO" formed over the original image. The second overlay image "LOGO" is formed based on second form-overlay*

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*data. The user may give the second modified copy printed in the third style ST3 to a client; col. 5, line 1-col. 6, line 58).*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teaching of Okimoto with Serbinis as modified by Usdin because Okimoto's teaching would have provided the capability for producing a plurality of document sets based on identical print data received from the external device and based further on the at least one macro selectively designated by the macro designating means to each of the plurality of document sets.

**As to claims 7 and 10:**

Serbinis teaches the management information includes information indicating a collection of a plurality of documents in a on the same layer (*e.g., Document objects 72A and 72B represent a generalized high level description of a document; col.7, lines 28-32*) and version number of the plurality of documents, and said client retrieves, based on the management information, by accessing from said server the collection of the plurality of documents in the same layer, the documents retrieved each having a specified version number, from the document database (*e.g., hierarchical storage scheme for storing electronic documents ... a generalized high level description of a document ...DMS system 17 also preferable supports multiple versions of documents ...the parent and child document instance, a version name and a unique version ID; col.7, lines 17-62 & Fig.3*).

**As to claims 8 and 11:**

Serbinis teaches the management information includes information concerning a security level corresponding to each of the plurality of documents and said server permits or inhibits retrieval of the document according the security level (*col.7, lines 8-62 & Abstract & Fig.2*).

**As to claim 1:**

The rejection of claim 6 is incorporated herein in full. Additionally, “*a printer connected to the client, the printer making a hard copy of a document displayed at the client*” is inherent to system of Serbinis.

**As to claim 3:**

Serbinis teaches the server registers, when a document registered in the document database is updated, the updated document in the document database, and also updates the version number information in the management information concerning the document (*col.6, lines 20-63*).

**As to claim 4:**

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Serbin teaches the server sends via the network to the server retrieval information for a document that has been retrieved, and the server sends via the network to the client, when a document corresponding to the retrieval information is updated, updating information related to the document updated (*col.6, line 63-col.7, line 18*).

**As to claims 2 and 5:**

Refer to the discussions of claims 7 and 8, respectively, for rejections.

**Response to Arguments**

5. Applicant's arguments filed 11/20/2006 have been fully considered but they are not persuasive.

Applicant argues that neither *Serbinis* nor *Usdin* teach "*a printer connected to the client, the printer making a hard copy of a document displayed at the client, including overlaid predetermined characters, in response to a tag being included in the management information which instructs to overlay the predetermined characters on the document displayed at the client*" [page 9, 1<sup>st</sup> full ¶].

In response, Applicant's arguments are substantially directed to the amended subject matter. The amended subject matter is addressed above with respect to the discussion of independent claims 1, 6, and 9.

### Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- |               |                       |                       |
|---------------|-----------------------|-----------------------|
| • Sato et al. | US Pat. No. 6,014,680 | Issued: Jan. 11, 2000 |
| • Nakao       | US Pat. No. 6,061,697 | Issued: May 9, 2000   |
| • Kato et al. | US Pat. No. 6,631,495 | Issued: Oct. 7, 2003  |
| • Hind et al. | US Pat. No. 6,635,088 | Issued: Oct. 21, 2003 |
| • Suehira     | US Pat. No. 6,922,697 | Issued: Jul. 26, 2005 |

### Contact information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

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